

## **REMARKS/ARGUMENTS**

### **B. In the Claims**

#### *I. Claim Rejections:*

The Application has 39 pending claims. Claims 14, 38, 40, and 47 are independent claims. The Office Action rejects all the claims of the Application under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0032573 to Williams (hereinafter, “*Williams*”) and Commerce One, an e-procurement services provider (hereinafter, “*Commerce One*”).

*The Present Application:* The embodiments of the present invention described in the Application provide systems and methods whereby shipping services are offered through an e-procurement/spend management application, which allows the user to purchase an assortment of tangible goods, such as supplies, in addition to shipping services.

*The Williams Reference (U.S. Patent Application No. 2002/0032573):* *Williams* was filed on March 27, 2001. The *Williams* reference is directed to a system and method for providing an enterprise, e.g., a business, with a single online user interface for providing access to a plurality of shipping service providers. When an employee of the enterprise needs to ship a package to a customer, the employee accesses an online user interface and inputs package information. Once the package information is entered, the system provides the employee, via an online display, with cost and delivery time comparisons between various shipping service providers. After choosing a particular shipping service from the various shipping service providers, the system provides the user with a shipping label.

Therefore, *Williams* does not disclose a method or system that integrates shipping services with an electronic procurement system configured such that a user can purchase shipping services in addition to tangible goods (e.g. office supplies, cleaning supplies, computer equipment, or other items that can be shipped). The system of the present invention is configured to maintain and implement a company’s procurement policy so that purchases of both tangible goods (e.g. office supplies) and shipping services are made in conformity with the

procurement policy. In contrast, *Williams* discloses a system solely dedicated to the purchase of shipping services.

As described above, *Williams* is materially and significantly different from the present application.

*The Commerce One Reference:* The Office Action goes on to combine *Williams* (shown above), with *Commerce One* to reject all of the pending claims of the application. The Office Action provides that *Commerce One* teaches a buyer procurement application configured to list preferred suppliers of goods and services, execute purchase transactions, and record transaction information regarding purchases made including but not limited to descriptions of the products or services purchased, an identification of the employee who make the purchase, the price of the purchase and the time of the purchase. The Office Action cites to an archived web site for Commerce One from archive.org's WayBack Machine.

Nowhere in the *Commerce One* reference does it discuss or suggest the integration of shipping services with an e-procurement system, the essence of the present invention. *Commerce One* is cited in the present Office Action for making it obvious to one of ordinary skill in the art at the time of the invention to add the shipping services of *Williams* to the buyer procurement application of Commerce One. Applicants respectfully submit that the *Commerce One* reference does not disclose, teach or make obvious the integration of shipping services to a prior art e-procurement system.

As described above, *Commerce One* is materially and significantly different from the present application.

*There is no Motivation to Combine Williams and Commerce One*

According to the Office Action, the alleged motivation to combine *Williams* and *Commerce One* is found at "Commerce One page 5 of 8, 1<sup>st</sup> paragraph," which states:

[p]urchased products and services are the single largest expense for most organizations, absorbing as much as half of every dollar earned in revenue. Given this, it's easy to see why reducing purchasing costs translates into dollar-for-dollar improvements in a company's bottom line.

Applicants contend that this statement does not provide the requisite motivation to combine the shipping services disclosed by *Williams* with the e-procurement system of *Commerce One* because the alleged motivation does not meet the requisite clear and convincing standard. The Federal Circuit has repeatedly emphasized that, to reject an inventor's claim for obviousness in view of a combination of prior art references, a showing of a suggestion, teaching, or motivation must be "clear and convincing." See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1994); *Inner International Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000) ("Although a reference need not expressly teach that the disclosure contained therein should be combined with another, . . . the showing of combinability, in whatever form, must nevertheless be 'clear and particular,'). Moreover, the requirement of describing a teaching or suggestion or motivation to combine is rigorously enforced to avoid the dangers of hindsight. See *Altech Controls, Corp., v. E.I.L. Instruments, Inc.*, 71 F.Supp.2d 643 (S.D. Tex. 1999).

Here, the omnibus statement about how reducing purchasing costs will improve a company's bottom line would not motivate one of skill in the art to particularly combine shipping services with an e-procurement system. While the allegedly motivating statement mentions "services," there is no specific suggestion to "shipping" services. Even the background section of the specification, on page 3, notes that the prior art included e-procurement systems capable of offering both manufactured goods and certain types of services. That being said, nothing in the prior art disclosed or suggested offering shipping services though online spend management or e-procurement systems.

Because the alleged motivation to combine *Williams* and *Commerce One* is not clear and particular enough in terms of suggesting that shipping services in particular be incorporated into prior art e-procurement systems, Applicants submit that such combination is improper.

**C. Conclusion**

In view of the remarks presented above, it is respectfully submitted that Claims 14, 17-34, 38-49, and 51-58 of the application are now in condition for allowance. Applicant therefore requests examination and allowance of all the pending claims of the Application. If the Examiner wishes to discuss the application or the comments herein, the Examiner is urged to contact the undersigned by telephone at (404) 881-4930.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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